IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of) Klotz Jr., et al.)) Serial No. 09/192,014)) Filed: November 13, 1998)) For: User Interface Identification and Service) Tags for A Document Processing System)	Group Art Unit: 2176 Examiner: W. Bashore

APPEAL BRIEF

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Assistant Commissioner for Patents
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Sir:

<u>BRIEF ON BEHALF OF KLOTZ JR, ET AL.</u>:

Appellant appeals from the final Office Action mailed July 2, 2003, in which currently pending Claims 1-6, 11, 14, and 15 stand finally rejected. Appellant mailed a Notice of Appeal on September 2, 2003. This appeal brief is submitted in triplicate in support of Appellant's appeal.

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1.   REAL PARTY IN INTEREST

The real party in interest is assignee Palo Alto Research Center, Inc., a California corporation, located at 3333 Coyote Hill Road, Palo Alto, CA 94304.

5   2.   RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellant, Appellant's legal counsel, or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

10   3.   STATUS OF CLAIMS

Finally-rejected Claims 1-6, 11, 14, and 15 are pending and are the subject of this appeal. The claims involved in this appeal are included in the Appendix.

4.   STATUS OF AMENDMENTS

15   A first non-final Office action ("first Office action") was mailed by the U.S. Patent & Trademark Office (USPTO) on December 19, 2001. In response, Appellant filed an Amendment Under 37 C.F.R 1.116 ("first Response") on April 19, 2002. Claims 7-10 and 12-13 were canceled. Claim 11 was amended. Claims 14 and 15 were added. A final Office action ("second Office action") was 20   mailed by the USPTO on July 29, 2002. In response, Appellant filed an Amendment under 37 C.F.R 1.116 ("second Response") on September 10, 2002. Claim 1 was amended. An Advisory Action was mailed by the USPTO on October 4, 2002. In response, Appellant filed a Continued Prosecution Application (CPA) on October 29, 2002. A third non-final Office action ("third 25   Office action") was mailed by the USPTO on January 15, 2003. In response, Appellant filed an Amendment Under 37 C.F.R. 1.111 ("third Response") on April 10, 2003. A fourth final Office action ("fourth Office action") was mailed by the USPTO on July 2, 2003. No Amendment After Final Office Action Pursuant to 37 C.F.R. § 1.116 was filed. A Notice of Appeal was filed on

September 2, 2003. Accordingly, no amendments have been filed subsequent to final rejection.

5. SUMMARY OF INVENTION

5   The invention provides a method and system for processing documents based on information in user interface tags affixed to the documents. A document affixed with a user interface tag is first scanned to create an image representative of the document. Then, the user interface tag containing user identification and service information is located in the image. The user interface tag is subsequently

10   decoded to retrieve an identity code representative of a user's identity and a service code specifying a service to be performed on the hardcopy document (Spec., p. 4). Based on the decoded data, the document is associated with a user and a service desired by the user. The service is then performed for the particular user (Spec., p. 4-5 and p. 9-10). Exemplary services include, non-exclusively,

15   "scan to document repository," "scan and send via e-mail," "scan and fax," "scan and print copies," and so forth (Spec., p. 7).

       The user interface tag bears a machine-readable data code containing data to associate the hardcopy document with a user and a service for scanning by a document processing system (Spec., p. 4). The machine-readable data code is a

20   recoverable printed representation of digital information, including, non-exclusively, bar codes, one and two dimensional data patterns, and optically recognizable alphanumeric characters (Spec., p. 7).

       A typical structure of the printed data code includes a service code, a service agreement, and an identity code (Fig. 2). The service code represents

25   possible actions, transformations and services that the user can specify. Exemplary services and transformations may include transforming the document from hardcopy to electronic form and from electronic form back to hardcopy (Spec., p. 8). The service agreement provides additional information regarding the actions specified by the service code (Spec., p. 8). Additional information can

include, non-exclusively, how, where, and when the actions need to be performed. Finally, the identity code contains identity and security information in sufficient detail to enable association of the document with a particular user.

Operationally, an identity processor first receives user information. Then,
5   the identity processor stores the information as a record in a database coupled to a database server. The identity processor processes the user information to produce an identity code. The identity code, desired service codes, and corresponding service arguments are then encoded and printed on a printer or other hardcopy output device to form service tags for the particular user (Spec., p. 9).

10   When the user wishes to process a document, the user attaches one of the service tags onto the document and places the document into a scanner. The scanner reads the document and formulates a bitmap representative of the document and service tag. An action processor processes the bitmap to identify and decode the identity, service codes and service arguments embedded in the
15   service tag (Spec., p. 9). The action processor determines and performs the desired services using other output devices (Spec., p. 9). Exemplary output devices non-exclusively include a hardcopy printer, a facsimile machine, a network connection for e-mail, a connection to a document repository, a digital storage device, and an aggregation of part or all these devices (Spec., p. 9).
20

6.   ISSUES

There are two issues presented on appeal. First, whether Claims 1-6 are unpatentable under 35 U.S.C. § 103(a) as obvious in light of U.S. Patent No. 6,192,165 ('165) to Irons and further in view of *Xerox touts Data Glyphs for*
25   *paper data* (Xerox) (Issue I). Second, whether claims 11, 14, and 15 are unpatentable under 35 U.S.C. § 103(a) as obvious in light of the '165 patent and further in view of U.S. Patent No. 5,998,752 ('752) to Barton (Issue II).

7.   GROUPING OF CLAIMS

A.   Issue I - First Rejection under 35 U.S.C. § 103(a).

For Issue I, claims 1-6 stand rejected under 35 U.S.C. § 103(a). Claims 1-6 stand or fall together.

5

B.   Issue II - Second Rejection under 35 U.S.C. § 103(a).

For Issue II, claims 11, 14, and 15 stand rejected under 35 U.S.C. § 103(a). Appellant believes that the following groups of claims 11, 14, and 15 are separately patentable. Claims 11, 14, and 15 do not stand or fall together with

10   respect to the rejection under 35 U.S.C. § 103(a) (Issue II), but instead are grouped together as follows:

Group I: Claims 11

Group II: Claims 14

Group III: Claims 15

15   An argument in support of the foregoing groupings of Claims 11, 14, and 15 is provided below in Section 8(B)(1).

8.   ARGUMENT

A.   Issue I - First Rejection under 35 U.S.C. § 103(a).

20   Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as obvious in light of U.S. Patent No. 6,192,165 to Irons and further in view of *Xerox touts Data Glyphs for paper data.* Applicant traverses the rejection and asserts that a *prima facie* case of obviousness has not been shown.

1.   '165 Reference (Irons).

25   The Irons reference describes an apparatus and method for a digital filing system involving receiving a paper-based document, indexing the document at the user's workstation, generating an image file name for the document, preparing a

tag for the document, applying the tag to the document, imaging or scanning the document, and electronically storing the document using the previously generated image file name and indexing information (Col. 6, lines 23-30). The stored electronic document then can be retrieved, viewed, or transmitted as desired by

5   the user.

Specifically, the Irons reference teaches using a desktop tagging mechanism to prepare a tag that contains a computer-readable two-dimensional bar code or other high-density symbology along with corresponding human readable information (Col. 6, lines 57-61). The high-density symbology includes

10   those tags that represent digital information as shading within an icon or other symbology capable of representing large quantities of information in a digital format (Col. 11, lines 18-21). The content of the tag includes a unique document number, a software serial number, a security code, an indexing data code, a UserID, and a document counter (Col. 11, lines 27-35). In addition, the machine-

15   readable portion may include additional information, such as information on document disposition or additional index data for the document (Col. 11, lines 23-26).

Operationally, after a document has arrived at a user's desk, the user designates file parameters for the document using a digital filing application. The

20   digital filing application creates and prints a tag for the document. After the user applies the tag to the document, the document is scanned and archived using the instructions printed on the tag. The original hardcopy document is disposed according to operational rules, color-coded Out baskets, eye legible tag content, and other user-determined methods. The original hardcopy may be returned to the

25   user, filed centrally, or destroyed. After image storage, the electronic copy of the document can be retrieved for review, printing, editing, and similar options (Col. 12, lines 21-67 through Col. 13, lines 1-15).

2.   Xerox Reference.

The Xerox reference discloses data-carrying elements ("glyphs"), which

are a group of line segments that slope either to the left or the right to encode a digital 1 or 0. By printing glyphs on a hardcopy document, the document can carry machine-readable information. Glyphs can carry any binary data including computer executable commands. Also, document controls can be embedded into
5   the glyphs, such as check boxes, signature regions, and clip regions. Glyphs can be printed by any ordinary office printer on a document and scanned by any ordinary office scanner from a document. Aesthetically, glyphs appear to be a uniform gray area that is very similar to an ordinary halftone tint on a document.

3. Patentability of Claims

10   The Irons and Xerox references, taken individually or as a whole, fail to teach or suggest the subject matter of Claims 1-6. Per MPEP § 2143, to establish a *prima facie* case of obviousness, (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the
15   reference teachings, (2) there must be a reasonable expectation of success, and (3) the combined references must teach or suggest all the claim limitations. All three requirements must be met before a *prima facie* case of obviousness is found.

     Neither Irons nor Xerox teaches or suggests to one of ordinary skill in the art to modify or combine the reference teachings to create a system as defined by
20   Claims 1-6. A suggestion can be found either explicitly or implicitly in the references or in the knowledge generally available to one of ordinary skill in the art. *See, In re Jones*, 958 F.2d 347 (Fed. Cir. 1992).

     Taken individually, Irons teaches an apparatus and method for a digital filing system. Specifically, Irons teaches embedding document information in a
25   user interface tag to uniquely identify a document in a digital filing system. Irons does not teach embedding service information in a tag to specify a *service* to be performed on the document. In Irons, the information provided in a tag is used to facilitate convenient archiving of the document. The enumerated information embedded in a tag includes a unique document number, software serial number,

security code, indexing data code, UserID, and document counter. The document

information is used by the digital filing system to identify a document and to

facilitate convenient retrieval of that document. The embedded information does

not call for any service such as "scan and send via e-mail," "scan and fax," and

5   "scan and print copies."

In addition, Irons teaches a designating disposition method, which is a

necessary step in the archiving process, but is not a service to be performed on a

hardcopy document. The embedded instruction code merely provides information

about how, where or when to dispose a document instead of calling for the

10   services to be performed on the original document. *See, e.g., Irons*, Figure 7, Step

790 (original hardcopy is disposed according to any of the operational rules, color-

coded Out baskets, eye legible tag content or other user-determined methods).

Xerox teaches a technique for printing binary data on paper. Binary data is

printed on a document by small line segments that slope in different directions.

15   Areas of the tag can be designated with special properties, such as check boxes

and signature regions. Xerox does not teach or suggest a method for processing a

-document based on information in a user interface tag. Specifically, Xerox does

not teach or suggest embedding service codes in the user interface tags for a

service to be performed on the document; instead, Xerox teaches a technique for

20   embedding digital information in a printed tag and subsequently detecting or

handling certain images on the document image itself.

In addition, considering the references together, the apparatus and method

described in Irons would derive no benefit from the Xerox reference. For

example, the signature verification feature in Xerox provides a method to

25   determine whether a signature space is blank on a form, but not whether the

signature is valid. Such verification is useful when a service called for depends

on the existence of a signature. However, in Irons, the purpose of the process is to

conveniently <u>achieve</u> documents digitally instead of further processing a hardcopy

document. In Irons, the user has already determined that the document does not

30   require further processing and merely needs to be filed and electronically stored.

Therefore, signature verification is unrelated to the disclosed invention in Irons.

Lastly, the combination of the Irons and Xerox reference does not teach all the claim limitations of claims 1-6. Neither Irons nor Xerox teaches a user interface tag encoded with service information to be performed on the document.

5   If the two references are combined, the resulting system would be a digital filing system utilizing a tag with document information, UserID, and so forth encoded with glyphs. The combination of the references does not teach encoding, placing, and decoding a user interface tag with service information on a document, *and* causing the specified service be performed on the electronic copy of the

10   document. *See, McGinley, The Franklin Sports, Inc.,* 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001) (evidence that references taught away from combination and would produce inoperative result probative of non-obviousness). As the combined references fail to teach or suggest all the claim limitations, there would be no expectation of success.

15   Consequently, failing to teach or suggest all the claim limitations and lacking a suggestion or motivation to modify or combine the reference teachings, a *prima facie* case of obviousness has not been shown per claims 1-6. Withdrawal of the rejection of claims 1-6 for obviousness is requested.

20   **B.**   *Issue II - Second Rejection under 35 U.S.C. § 103(a).*

Claims 11, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as obvious in light of the '165 patent and further in view of U.S. Patent No. 5,998,752 ('752) to Barton. Applicant traverses the rejection and asserts that a *prima facie* case of obviousness has not been shown.

25   1.   Grouping of Claims

Group I consists of claim 11. Claim 11 recites a user interface tag encoded with service information and support can be found in the specification on page 6 through page 15 and in the accompanying FIGURES 1 and 10-14. As claim 11 recites a user interface tag with elements supportable by the specification

distinctively from other apparatus and system claims, Group I properly states a separately patentable claim group.

Group II consists of claim 14. Claim 14 recites an apparatus for creating user interface tags for requesting services to be performed on documents and

5   support can be found in the specification on page 6 through page 10 and in the accompanying FIGURES 1-5. As claim 14 recites specific apparatus elements supportable by the specification distinctively from the user interface tag claim and the system claim, Group II properly states a separately patentable claim group.

Group III consists of claim 15. Claim 15 recites a document service

10   system having a tag-based user interface for performing services on documents and support can be found in the specification on page 6 through page 10 and in the accompanying FIGURE 1-5. As claim 15 recites specific system elements supportable by the specification distinctively from the user interface tag claim and the tag creating apparatus claim, Group III properly states a separately patentable

15   claim group.

2.   '752 Reference (Barton).

Barton is directed toward a sorting system based on codes attached to each document (Abstract). An exemplary code includes a machine-readable routing code (Col. 4, lines 66-67). If the code on a document is readable, the document is

20   processed based on the code. If the code on a document is not readable, the codes of the documents proceeding and following are transmitted to a computer system for inferring the unreadable code. If the code can be inferred, the document is processed accordingly; otherwise, the document is rejected (Col. 2, lines 20-45).

3.   Patentability of Group I Claims

25   As described above, Irons reference fails to teach and lacks a suggestion or motivation to modify or combine the reference teachings to provide a service code embedded in the tags as defined in claim 11. Instead, Irons teaches a method and system to conveniently archive documents electronically.

Similarly, Barton does not teach or suggest a tag encoded with information

that calls for a service to be performed on the document. Barton teaches a tag containing a routing code for tracking documents in a sorting system. When the routing code is not readable, a computer system attempts to infer the contained code from other codes in documents prior to and after the document with the

5   unreadable code. Even though a routing code may facilitate a service, such as delivering a document to a certain location, the routing code *itself* does not define, describe or call for a service to be performed. In Barton, the service performed is to deliver documents to destinations called for in routing codes. The service has already been determined before the routing code is even encoded. Therefore, the

10   routing code does not define a service; the routing code merely facilitates the service.

Taken together, both Irons and Barton references fail to teach all the claim limitations of claim 11. Neither Irons nor Barton teaches a user interface tag encoded with service information to be performed on the document. If the two

15   references were combined, the resulting system would be a digital filing system utilizing a tag with document information, UserID, and a routing code to direct where the document is delivered. The combination of the references does not teach or suggest creating a printed tag encoded with service information requesting services to be performed on a document. *See, McGinley, The Franklin*

20   *Sports, Inc.*, 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001) (evidence that references taught away from combination and would produce inoperative result probative of non-obviousness). As the combined references fail to teach or suggest all the claim limitations, there would be no expectation of success.

Consequently, failing to teach or suggest all the claim limitations and

25   lacking a suggestion or motivation to modify or combine the reference teachings, a *prima facie* case of obviousness has not been shown per claim 11. Withdrawal of the rejection of claim 11 for obviousness is requested.

4.   Patentability of Group II Claims

As described above, Irons reference fails to teach and lacks a suggestion or

motivation to modify or combine the reference teachings to provide an apparatus to encode a user interface tag with service information as defined in claim 14. Instead, Irons teaches a method and system to encode a user interface tag with document information to facilitate convenient archive documents electronically.

5   Similarly, Barton does not teach or suggest that encoding a tag with information that calls for a service to be performed on the document as described above. Furthermore, Barton does not teach or suggest an apparatus to encode a user interface tag with service information. The apparatus disclosed in Barton is a computer for tracking documents in a sorting system with capability to infer

10   routing codes when a routing tag is not readable.

Taken together, both Irons and Barton references fail to teach all the claim limitations of claim 14. Neither Irons nor Barton teaches an apparatus to encode a user interface tag with service information. If the two references were combined, the resulting system would be a digital filing system utilizing a tag with document

15   information, UserID, and a routing code to direct where the document is delivered. The combination of the references does not teach an apparatus that creates a printed tag encoded service information. *See, McGinley, The Franklin Sports, Inc.*, 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001) (evidence that references taught away from combination and would produce inoperative result

20   probative of non-obviousness). As the combined references fail to teach or suggest all the claim limitations, there would be no expectation of success.

Consequently, failing to teach or suggest all the claim limitations and lacking a suggestion or motivation to modify or combine the reference teachings, a *prima facie* case of obviousness has not been shown per claim 14. Withdrawal

25   of the rejection of claim 14 for obviousness is requested.

5.   Patentability of Group III Claims

As described above, Irons reference fails to teach and lacks a suggestion or motivation to modify or combine the reference teachings to provide a system that decodes embedded service information from a user interface tag after scanning a

document and causes the service to be performed on the document as defined in claim 15. Instead, Irons teaches a method and system to decode document information embedded in a user interface tag and use the information for conveniently archiving documents electronically.

5   Similarly, Barton does not teach or suggest a system decoding service information embedded in a tag calling for a service to be performed on the document. Barton teaches a computer that tracks documents in a sorting system by monitoring routing codes embedded in document tags. In Barton, the service is to deliver documents to the destination called for in routing codes in a sorting

10   system. The service has already been determined before a routing code is even encoded. Routing codes in Barton do not define services; the routing code merely facilitates the service to deliver documents to a destination.

Taken together, both Irons and Barton references fail to teach all the claim limitations of claim 15. Neither Irons nor Barton teaches scanning a document

15   with a tag encoded with service information to be performed on the document. If the two references were combined, the resulting system would be a digital filing system utilizing a tag with document information, UserID, and a routing code. After scanning the document, the document is routed to a destination specified by the routing code. No services, such as "scan and fax" and "scan and e-mail" are

20   performed. The combination of the references does not teach decoding service information from a user interface tag, and causing the specified service be performed on the document after scanning. *See, McGinley, The Franklin Sports, Inc.*, 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001) (evidence that references taught away from combination and would produce inoperative result

25   probative of non-obviousness). As the combined references fail to teach or suggest all the claim limitations, there would be no expectation of success.

Consequently, failing to teach or suggest all the claim limitations and lacking a suggestion or motivation to modify or combine the reference teachings, a *prima facie* case of obviousness has not been shown per claim 15. Withdrawal

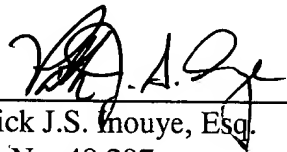30   of the rejection of claim 15 for obviousness is requested.

9.   CONCLUSION

In view of the foregoing arguments, Applicant respectfully submits that the rejections under 35 U.S.C. § 103(a) (Issue I) and 35 U.S.C. § 103(a) (Issue II)

5   cannot be sustained and should be withdrawn. Reconsideration of the pending claims and a Notice of Allowance is respectfully solicited.

Please contact the undersigned at (206) 381-3900 regarding any questions or concerns associated with the present matter.

10

Dated: November 3, 2003   By: _____

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Appeal Brief

10.   APPENDIX

1   1.   A method for processing a document based on information in a

2   user interface tag, comprising the steps of:

3   scanning the document to produce an image representative of the

4   document;

5   locating the user interface tag in the image;

6   decoding data represented in the user interface tag;

7   associating the data with a service and a user identity; and

8   performing the specified service on the image representative of the

9   document.

1   2.   The method of claim 1, wherein the step of locating the user

2   interface tag comprises the steps of:

3   identifying a connected component in the image;

4   finding a plurality of extreme points within the connected component;

5   determining whether a diagonal length may be present between two of the

6   plurality of extreme points;

7   if so, identifying corners of a border candidate; and

8   determining whether a correctly-dimensioned rectangular shape is defined

9   by the corners.

1   3.   The method of claim 1, wherein the step of decoding the data

2   comprises the steps of:

3   determining a lattice of glyphs represented in the user interface tag;

4   identifying a seed glyph within the lattice;

5   finding all glyphs within the lattice;

6   identifying the rotation of the lattice; and

7   converting the glyphs to binary data.

1   4.   The method of claim 1, wherein the step of associating the data

2   with a service and a user identity comprises the steps of:

3   extracting a user identity code from the data; and

4   accessing a database to determine user identification information

5   associated with the identity code.

1   5.   The method of claim 4, further comprising the steps of:

2   extracting a service code from the data; and

3   accessing a database to determine service information associated with the

4   service code.

1   6.   The method of claim 4, further comprising the step of accessing a

2   database to determine service information associated with the identity code.

1   11.   A user interface tag bearing a machine-readable printed data code,

2   wherein the tag is adapted to be associated with a hardcopy document for

3   scanning by a document processing system, and wherein the data code comprises

4   an identity code representative of a user's identity and a service code specifying a

5   service to be performed on said hardcopy document.

1   14.   An apparatus for the creation of user interface tags for use in a tag-

2   based document service system, comprising:

3   an identity processor adapted to receive user information and create an

4   identity code;

5   a user information database associating the user information with the

6   identity code; and

7   an output device capable of printing a tag bearing a machine-readable

8   printed data code representative of the identity code and a service to be performed

9   on a document to which said user interface tag is affixed.

1   15.   A document service system having a tag-based user interface,

2 comprising:

3   a scanner adapted to receive a hardcopy document and produce a digitized

4 image of the document;

5   an action processor adapted to identify a user interface tag image within

6 the digitized image and to decode information represented in the user interface

7 tag, said information including information indicating a service to be performed

8 on said hardcopy document; and

9   a device operated by the action processor responsive to the service

10 information represented in the user interface tag.

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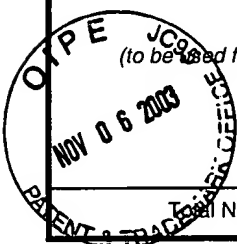
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Filing Date	11/13/1998
First Named Inventor	Klotz Jr., et al.
Group Art Unit	2176
Examiner Name	William L. Bashore
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